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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,294	09/07/1999	RICHARD C. WILSON	CBC-122-C	8383

7590 10/27/2005

ANDREW R BASILE  
YOUNG & BASILE PC  
3001 WEST BIG BEAVER ROAD SUITE 624  
TROY, MI 480843107

EXAMINER
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CANFIELD, ROBERT

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Interview Summary</b>	Application No.	Applicant(s)	
	09/391,294	WILSON ET AL.	
	Examiner	Art Unit	
	Robert J. Canfield	3635	

All participants (applicant, applicant's representative, PTO personnel):

(1) Robert J. Canfield. (3) \_\_\_\_\_.

(2) Darlene Condra. (4) \_\_\_\_\_.

Date of Interview: 10/24/05.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: none.

Identification of prior art discussed: none.

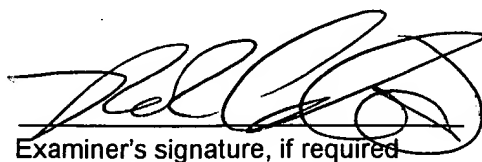
Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: In response to the Order Returning the application from the Board or Appeals because page 9 of the Final rejection mailed 10/20/00 was not parts of the electronic file the examiner requested Darlene Condra fax him a copy of the missing page. The missing page was faxed and the examiner has attached a complete copy of the 10/20/00 Final Rejection.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Robert Canfield  
Primary Examiner

  
Examiner's signature, if required

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.



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Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/391,294	09/07/99	WILSON	R CBC-122-C

ANDREW R BASILE  
YOUNG & BASILE PC  
3001 WEST BIG BEAVER ROAD SUITE 624  
TROY MI 48084-3107

PM82/1020

EXAMINER
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CANFIELD, R

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 10/20/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

*COMPLETE COPY OF 10/20/00 FINAL  
REJECTION*

# Office Action Summary

Application No.  
09/391,294

Applicant(s)  
Wilson et al.

Examiner  
Robert Canfield

Group Art Unit  
3635



☒ Responsive to communication(s) filed on Aug 7, 2000

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-12 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. This Office action is in response to the amendment filed 08/07/00. Claims 1-12 are pending. Claims 13-23 have been canceled.

2. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

It fails to properly identify the specification to which it is directed as required by 37 CFR

1.63(a)(2). The declaration refers to U.S. Patent 5,542,222 not U.S. Patent 5,664,736.

It fails to identify each inventor's residence and post office address as required in 37 CFR

1.63(a)(3),

It fails to recite that the inventors are joint inventors as required by 37 CFR 1.63(a)(4),

It fails to provide a statement that the person signing has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the declaration as required by 37 CFR 1.63(b)(1),

It fails to state that the persons signing believe the named inventor or inventors to be the original and first inventors of the subject matter which is claimed and for which a patent is sought as required by 37 CFR 1.63(b)(3),

It fails to state that the person signing acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 as required by 37 CFR 1.63(b)(3).

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3. Claims 1-12 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action. A supplemental declaration is required as well. See MPEP 1414.01.

4. Claims 1-12 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The limitations "single member" and/or "wherein said first and second longitudinally extending portions have lengths corresponding to the length of the corner of the building" have been omitted from the claims. These limitations were presented in amendments in application

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serial number 08/639698 filed on 04/29/96 and 12/06/96. Applicant's remarks in these amendments contains arguments that these limitations make the claims allowable over the prior art of record. Thus, the omitted limitations relate to subject matter previously surrendered, in application serial number 08/639698.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 5-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There is an inadequate written description of "at least two single members" and there relationship.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:



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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 9, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,455,797 to Naka.

See the embodiment of figure 4. A member 51 fabricated from a material having insulating qualities (extruded synthetic resin) is provided for extending along an external corner of a building structure. The member has first and second portions lying in angularly disposed planes for contacting the external corner and spaced apart outer surfaces. Each portion has an radially outwardly extending flange 13.

The claims are drawn to the support member alone in subcombination with the building and corner presented as an intended use environment. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Naka meets each of the structural elements recited in the claims.

9. Claims 1, 2, 4-6, 8-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,091,316 to Hauck.

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Hauck provides in figure 2 a member 6 having first and second longitudinally extending portions defining a cornered inner surface each having a radially outwardly extending flange 5. Again note that the claims are considered to be drawn to the member alone not in combination with a building and corner post. The wood 6 is a material having insulating qualities.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,455,797 to Naka.

Naka provides each of the elements of these claims except that the material selected is polystyrene foam plastic.

Naka recites that the material selected for the member be an extruded synthetic resin.

One of ordinary skill in the art would have recognized extruded polystyrene foam as a synthetic resin at the time of the invention. Polystyrene foam would have been an obvious choice of material at the time of the invention to one having ordinary skill in the art for the member of Naka as it falls within the broader materials suggested by Naka of a synthetic resin. Polystyrene is

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well recognized in the building construction arts as a material choice where synthetic resins are used for its inherent material properties such as insulating properties and ease in extruding.

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-12 are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 5,542,222 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a support member having first and second longitudinally extending portions, the first portion lying in a first plane angularly disposed to the second portion lying in a second plane, the

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support member formed from a material having insulating qualities (polystyrene foam) and the first and second portions having respective first and second support member flanges extending longitudinally and radially outward.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

14. Applicant's arguments filed 08/07/00 have been fully considered but they are not found fully persuasive.

As to the recapture rejection, regardless of the intended meaning of the limitations by applicant's own admission in his remarks in the last response the limitations "single member" and "length corresponding to the length of the corner of the building" were added during the prosecution to overcome a rejection. Therefore these limitations must be present in all of the claims of the instant application. The examiner notes that there is a difference between "corresponding to the length of the corner of the building" and "adapted to correspond to the length of the corner of the building". The rejection under 35 U.S.C. 112(2) in paragraph 9 of the previous Office action is a totally different issue than the recapture issue.

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Applicant's arguments concerning the rejection of claims 9-12 as they pertain to Naka have not been found persuasive. The examiner disagrees that Naka fails to show first and second support members and flanges lying in first and second planes. Figure 4 clearly shows portions 51 and flanges 13 lying in planes at substantially right angles to one another. The rejection of claims 1-8 have been vacated because Naka does not teach or adequately suggest the outer cornered surface being parallel to the inner cornered surface. This limitation is not found in claim 9.

The examiner disagrees that Hauck shows two pieces of wood connected together. There is no line indicating wood 6 is formed from two separate pieces. Further, wood is considered an insulating member.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Canfield whose telephone number is (703) 308-2482. The examiner can normally be reached on M-Th.

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2138.

Robert Canfield

March 20, 2000

Robert Canfield  
Primary Examiner